

REMARKS/ARGUMENTS

Claims 27, 30 to 33, 36 to 42, 44 to 47 and 49 to 51 remain in this application.

Claims 1 to 26, 28, 29, 34, 35, 43 and 48 have been canceled.

Claim 48 is currently canceled, removing an issue on appeal.

Claims 27, 37, 38, 40, 44 and 46 are currently amended to improve definiteness.

The scope of claims 27, 37, 38, 40, 44 and 46 has not changed and no new issue has been raised. As argued in the previous Amendment and Response, the independent claims either require a seamless resilient wear layer that covers substantially the entire surface covering or resilient flooring sheet, including the two elements and the seam (claims 27 and 40), the seam running the width of the roll (claim 37) or the gluing surfaces being in a plane generally parallel to the axis of the roll (claim 44). Claims 38 and 46 depend from claims 37 and 44, respectively. Therefore, it is respectfully requested that the amendments to claims 27, 37, 40 and 44 be entered.

Attorney for Applicants wishes to thank the Examiner for the withdrawal of the rejections based on Shih, MacLaine in view of Webster's New World Dictionary, MacLaine in view of Webster's New World Dictionary and in further view of Ehrhart, and MacLaine in view of Webster's New World Dictionary and in further view of Pacione.

Claims 27, 36 and 48 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that claim 48

contradicts claim 36. Claim 48 has been canceled. Therefore, the section 112 rejection of claims 27 and 36 should be withdrawn.

Claims 27, 30, 36 to 42 and 44 to 51 have been rejected as being obvious over MacLaine et al. US Patent No. 3,615,994 (MacLaine) and Webster's New World Dictionary in view of Pacione US Patent No. 6,298,624 (Pacione).

Claims 27, 38, 40 and 46 require a seamless resilient wear layer that covers substantially the entire surface covering or resilient flooring sheet, including substantially all of the two elements and the seam. Below the middle of page 5 of the Office Action mailed February 8, 2005 ("latest Office Action"), the Examiner states that

"Pacione teaches a resilient covering layer that covers the entire surface covering component, including the two elements and the seam formed by adjacent gluing surfaces and adhesive (figure 4 numbers 9, 13, 15) for the purpose of installing a decorative cover (col. 1 lines 13-17)."

However, Pacione does not teach wear layer or a covering layer that covers substantially the entire surface covering or resilient flooring sheet, including substantially all of the two elements and the seam. The carpet piece 15, shown in Figure 4, covers the seam between the two adjacent elements (covering pieces 9) and one of the covering pieces 9, but it does not cover substantially all of the second covering piece 9, as required by claims 27, 38, 40 and 46.

Further, claims 27, 38, 40 and 46 require the wear layer to be seamless. There is no suggestion to replace the carpet piece 9 of Pacione with a seamless carpet which would cover the seam and two covering pieces 9 of the anchor sheet. If the Examiner disagrees, she respectfully requested to point out such suggestion in Pacione, as required by 37 C.F.R. 1.104(c)(2).

At the middle of page 8 of the latest Office Action, the Examiner argues that “[a]lthough Pacione discloses that the carpet which is the wear layer comes in many pieces, the carpet pieces combined together is still one layer that covers substantially the entire surface covering including two elements and the seam formed by the adjacent gluing surfaces and adhesive.” While the one layer does cover substantially the entire surface covering, it is not seamless as required by claims 27, 38, 40 and 46.

At the top of page 9 of the latest Office Action, the Examiner argues that carpet is notoriously well known in the prior art to be a seamless, resilient wear layer and concludes that therefore Pacione does disclose a seamless, resilient wear layer, referring to Figure 4, number 15. Again, the carpet piece 15 of Figure 4 does not cover substantially all of the two adjacent covering pieces 9. The invention of Pacione is an “anchor sheet [that] acts to tie the decorative covering [carpet pieces 15] together as a functional unit.” (Column 1, lines 13 to 15.) If the carpet pieces were substituted with a seamless carpet, the invention of Pacione would be destroyed. The pieces would not be tied together by the anchor sheet.

Further, there is no suggestion to combine MacLaine and Pacione, since to do so would destroy the invention of MacLaine. MacLaine is directed to a cushioned vinyl sheet that can be rolled. See roll 74 in Figures 6 to 8. The wear layer 3 of MacLaine is adhered to the foamed vinyl backing 5 and backing layer 6 before the laminated strips 1, 2 are joined together in a butt joint of the MacLaine invention. See Figure 1 and column 2, lines 3 to 12. The invention of MacLaine is a product that can be produced by butt joining the edges of the cushioned vinyl strips. See column 1, lines 30 to 32.

There is no suggestion or reason to cover the wear layer of MacLaine with the carpet or other decorative covering of Pacione. By doing so the MacLaine wear layer no longer functions as a wear layer. It is improper for the Examiner to use hindsight reasoning to pick and choose elements of the two references to combine.

Even if hindsight reasoning were used to pick and choose the elements, the elements are not comparable. The vinyl wear layer 3 of MacLaine is adhered to the remainder of the laminated cushioned vinyl sheet before the vinyl sheet is joined in a butt joint. The joined sheets are then rolled. The Pacione anchor sheets 9 are installed on the subfloor and attached to one another before the carpets pieces 15 are laid over the anchor sheets. The combined carpet and anchor sheets are not intended to be rolled.

Claims 38 and 46 depend on claims 37 and 44, respectively. Therefore, they require the seamless resilient wear layer to be part of a surface covering or resilient flooring sheet which is in the form of a roll. The combination of MacLaine and Pacione does not teach a seamless wear layer overlying a seam in a surface covering or resilient flooring sheet which is in roll form. To yield the claimed invention, one would need to remove the wear layer of MacLaine, butt joint the MacLaine vinyl sheets, adhere a seamless wear layer to the butt joined sheets, and then roll the seamless wear layer coated and butt joined sheet. There is no teaching or suggestion to change the order of manufacturing steps in MacLaine. If the Examiner disagrees, she is respectfully requested to point out where the teaching or suggestion occurs.

Claims 40 and 46 are directed to a resilient flooring sheet comprising two resilient sheet elements and a seamless resilient wear layer. Therefore, the ASTM F141 definition for resilient floor applies, i.e. a sheet of which the wearing surface is non-textile.

Attorney for Applicants does not understand the statement in the carryover paragraph on pages 8 and 9 of the latest Office Action:

“Applicant ... fails to realize that the term ‘wear layer’ is directed the ‘resilient floor *covering*’ and not the resilient floor itself. The covering for a resilient flooring does need to be ‘nontextile’ however, the wearing surface of the resilient flooring does as defined by the definition of ‘resilient flooring’ as provided by the applicant.”

(Italics in original.) The terms “resilient flooring” and “resilient floor covering” are synonymous in the floor covering industry. Claims 40 and 46 are directed to a resilient flooring sheet and does not specify a covering for the resilient flooring sheet. The wear layer is adhered to and is a part of the resilient flooring sheet.

With respect to claims 37, 39, 42 and 45, the Examiner looks to the Webster’s New World Dictionary for a teaching of a scarf joint. The limitations of claims 49 to 51 are met by the definition of a scarf joint and will not be argued. Claims 39, 42, 45 and 49 to 51 depend directly or indirectly on claims 37, 40 or 44 and are allowable for the same reasons that claims 37, 40 and 44 are allowable.

Independent claim 37 requires the seam to run the width of the rolled surface covering. The seam in MacLaine runs the length of the rolled sheet and not the width of the rolled sheet. Therefore, claim 37 is allowable over MacLaine and Webster’s New World Dictionary in view of Pacione.

With respect to claim 44, the Examiner takes the position at the top of page 5 of the latest Office Action that when the seam of MacLaine is made with a scarf joint, the gluing surfaces are in a plane generally parallel to the axis of the roll. This is incorrect. The butt joint seam of MacLaine runs along the length of the cushioned vinyl sheet. Therefore, when the sheet of MacLaine is wound on roll 74, as shown in Figures 6 to 8,

the seam is in a plane generally perpendicular to the axis of the roll. If the gluing surfaces were modified to form a scarf joint, the gluing surfaces of one revolution of the roll would form a shape generally like a segment of a cone having the same axis as the roll. The gluing surfaces would be in a plane generally parallel to the axis of the roll if the scarf joint seams ran the width of the rolled sheet. Again, the seam in MacLaine runs the length of the rolled sheet. Therefore, claim 44 is allowable over MacLaine and Webster's New World Dictionary in view of Pacione.

For the reasons discussed above, it is believed that the present claims are allowable. Therefore, Applicants respectfully request that a timely Notice of Allowance - be issued in the application.

Respectfully submitted,

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Date

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